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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,773	01/13/2000	John D. Dreher	2870/220	7449

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EXAMINER

BERMAN, ALYSIA

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/02/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/482,773

Applicant(s)

DREHER, JOHN D.

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. Receipt is acknowledged of the information disclosure statement filed January 2, 2002 and the amendment and associate power of attorney filed April 11, 2002. Claims 1, 32 and 33 have been amended. Claims 1-34 are pending and their status is as follows.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

3. Claims 6, 12-14, 17-20 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 6, 12-14, 17-20 and 24 are vague and indefinite because of the term, "non-matte". This rejection is maintained for reasons of record. The specification does not provide an exclusive definition of this term. The metes and bounds of the claim cannot be determined.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-8 and 12-17 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,690,916 (916).

This rejection is maintained for reasons of record. US '916 discloses cosmetic composition comprising a coherent light component (interference pigment) that provides interference action when applied to the skin (col. 2, lines 16-21). The interference pigment is preferably titanium oxide coated mica (col. 2, lines 32-33). The reference teaches that the interference pigment may exhibit a blue color when desired to mask a specific skin defect (col. 4, line 65 to col. 5, line 4 and col. 5, lines 19-26). For additional interference pigment see column 6, lines 57-65. Iron oxide may be coated onto the interference pigment (col. 7, lines 22-29).

Additional powders that may be incorporated into the composition are inorganic powders such as mica, muscovite, synthetic mica, boron nitride, titanium dioxide, iron oxide, titanium oxide coated talc, titanium oxide coated mica, bismuth oxychloride, aluminum powder, *inter alia* (col. 9, lines 18-60). In Table 2 at column 14, US '916 exemplifies compositions comprising titanium oxide coated mica that exhibits a blue interference color with titanium dioxide, iron oxide and mica. See also Tables 4, 6 and 8. Example 13 at column 28 exemplifies a powdery foundation that comprises talc, sericite, titanium oxide coated mica that exhibits a blue interference color and red, yellow and black iron oxides. See also claims 1-6.

US '916 teaches a cosmetic composition comprising an interference pigment that exhibit a blue interference color, metal oxides such as titanium dioxide and iron oxides and inorganic, non-matte, non-spherical powders such as bismuth oxychloride as

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instantly claimed. US '916 teaches application of these compositions to the skin. The application of the prior art compositions that contain the same components as instantly claimed to the skin inherently reduces the appearance of lines and wrinkles on the skin.

7. Claims 1-5, 9, 21-23, 25, 26 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 99/66883 (883).

This rejection is maintained for reasons of record. WO '883 discloses a composition for topical application to the skin that comprises at least one interference pigment and at least one non-interference pigment. The compositions reduce the appearance of flaws and defects in the skin. See the abstract. WO '883 discloses that the most common interference pigments are micas layered with 50-300 nm films of titanium dioxide, iron oxide or chromium oxide (page 4, lines 26-27). Examples of these pigments are those sold under the trade names Timiron™ and Flamenco™, *inter alia* (page 4, line 30 to page 5, line 2). The amount of interference pigment in the compositions is from about 0.05 to 90% by weight, with most products containing from about 0.5 to 15% (page 5, lines 11-22).

Additional pigments that may be incorporated into the compositions are, for example, iron oxides (page 5, lines 33-34) and titanium dioxide (page 6, line 1). The amount of these pigments in the compositions is about 1-20% by weight of the composition (page 6, lines 21-23). Additional powders that may be incorporated into the composition in an amount from 0.001 to 20% by weight (page 6, line 31 to page 7, line 8). One such powder is the inorganic powder calcium aluminum borosilicate. Example 1 at page 10 teaches a composition comprising titanium dioxide coated mica, iron oxides

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and titanium dioxide. See also claims 1, 3 and 6-8. Application of the prior art composition to the skin inherently reduces the appearance of lines and wrinkles.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US 5,690,916 (916) or WO 99/66883 (883) each in view of the other.

This rejection is maintained for reasons of record. US '916 teaches all the limitations of the claims as stated above. It does not teach about 1-9% by weight of interference pigment, about 0.1 to 30% of a metal oxide and about 2-20% of bismuth oxychloride. WO '883 teaches all the limitations of the claims as stated above. It does not teach inorganic, non-matte, non-spherical powders.

US '916 teaches inorganic, non-matte, non-spherical powders such as bismuth oxychloride as stated in the 35 U.S.C. 102(b) rejection above. WO '883 teaches weight percent ranges of components within the instantly claimed ranges as stated in the 35 U.S.C. 102(e) rejection above. WO '883 further teaches at page 5, lines 19 to 22 that it is within the skill in the art to determine an optimum concentration of interference pigment in order to achieve a desired effect. Each reference makes up the deficiencies of the other.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare either the composition of US '916 using the amounts of components as taught by WO '883 or the composition of WO '883 and add bismuth oxychloride as taught in US '916 with the reasonable expectation of providing a cosmetic composition that reduces the appearance flaws and defects of the skin.

### ***Response to Arguments***

10. Applicant's arguments filed April 11, 2002 have been fully considered but they are not persuasive.

11. Applicant argues that the means for determining matteness of a powder are known in the art as evidenced by the disclosure of US 6,027,738 (738). The Examiner would like to note that this reference was not provided with the amendment as stated by Applicant. The Examiner could not find any reference in US '738 to a standard method of measuring matteness of a powder. Without guidance of how to measure the matteness of a powder, the metes and bounds of the claims cannot be determined. A reference providing a standard method for measuring the matteness of a powder would be given fair review.

12. Applicant argues that the extensive list of non-matte powders provided by Applicant in the instant specification provides sufficient guidance and support for non-matte powders. Applicant states that one of ordinary skill in the art would only have to compare a powder that is not listed to a powder that is listed to determine matteness of the non-listed powder. As stated in the Office Action mailed October 30, 2001, matteness is a relative term. The term "non-matte" is not defined by the claim, the

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specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

13. Applicant argues that the Examiner has not provided any technical support for the statement that all skin exhibits lines and wrinkles. Applicant poses the question of whether the Examiner intends that even the skin of a newborn baby exhibits lines and wrinkles. The answer to this question is, "yes." All skin is inherently textured with lines and wrinkles. For example, the skin has lines and wrinkles at the joints. Additionally, all people are born with a very distinct set of lines on the pads of their fingers that are known as fingerprints. One merely has to look at anyone's skin to see that lines and/or wrinkles are present. The compositions of the prior art contain the same components as instantly claimed and are applied to the skin. A composition containing the same components and used in the same manner inherently exhibits the same properties. Burden is shifted to Applicant to show that the compositions of the prior art do not reduce the appearance of lines and/or wrinkles of the skin.

14. Applicant argues that WO '883 does not disclose a blue or violet interference pigment. WO '883 discloses titanium dioxide, iron oxide and chromium oxide layered mica such as Timiron and Flamenco. Applicant discloses at page 3 of the instant specification that titanated mica such as Timiron and Flamenco have blue or violet reflectance color. WO '883 discloses the identical pigments as disclosed by Applicant. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or



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claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP §2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product.

15. Applicant argues that neither reference teaches reduction of lines and wrinkles of the skin. As stated above and previously, the prior art teaches application to the skin of compositions containing the same components as instantly claimed. All skin contains lines and wrinkles. Therefore, applications of the compositions of the prior art to the skin inherently reduce the appearance of lines and wrinkles. Burden is shifted to Applicant to show that the methods of the prior art do not result in the instantly claimed effects.

16. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the prior art teaches topical application to the skin of compositions that contain the same components as instantly claimed. WO '883 teaches that the compositions are applied to reduce the appearance of skin flaws. It is reasonable for one of ordinary skill in the art to interpret skin flaws as encompassing lines and wrinkles.

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One of ordinary skill in the art would reasonably expect that the prior art compositions would reduce the appearance of lines and wrinkles of the skin.

### ***Conclusion***

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

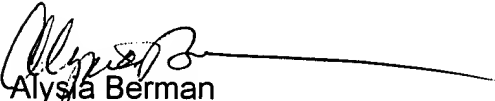
### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.

  
Alycia Berman  
Patent Examiner  
June 21, 2002

  
RUSSELL TRAVERS  
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